

REMARKS

Claims 22-25 are pending in the Application. Claims 22-24 are rejected under 35 U.S.C. §101. Claims 22-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting. Claims 22-25 are rejected under 35 U.S.C. §102(e). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

I. REJECTIONS UNDER 35 U.S.C. §101:

The Examiner has rejected claims 22-24 under 35 U.S.C. §101 because the claimed invention allegedly is directed to non-statutory subject matter. In particular, the Examiner rejects claims 22-23 under 35 U.S.C. §101 because they do not claim a practical application with a tangible result. Office Action (7/27/2006), page 2. Further, the Examiner rejects claim 24 under 35 U.S.C. §101 because claim 24 is allegedly claiming an intangible software program. *Id.* Applicants respectfully traverse.

The Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent. M.P.E.P. §2106. The subject matter courts have found to be outside the four statutory categories is limited to subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon. *See, e.g., Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874); M.P.E.P. §2106. Claim 22 is directed to a method, which is not outside the four statutory categories, for creating a technical framework for use in delivering a specific set of information technology services for a customer. Claim 23 is directed to a technical framework, which is not outside the four statutory categories, for use in delivering a specific set of information technology services for a customer. Claim 24 is directed to a computer program product for storage on a computer readable medium, which is not outside the four statutory categories, for creating a technical framework for use in delivering a specific set of information technology services for a customer.

Applicants respectfully contend that the claimed inventions in claims 22-24 satisfy the test for statutory subject matter recited in *In re Alappat*, and repeated in *State*

*Street Bank & Trust Co. v. Signature Financial Group*, and *AT&T Corp. v. Excel Communications, Inc. In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1526, 50 U.S.P.Q.2d 1547 (Fed. Cir. 1999). The claimed inventions produce a useful, concrete and tangible result in, *inter alia*, creating a technical framework for use in delivering a specific set of information technology services for a customer.

The essential inquiry under *In re Alappat* is to determine whether the claimed subject matter as a whole is directed to a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea" or if, in contrast, the mathematical concept has been reduced to some practical application rendering it useful. *AT&T Corp.*, 172 F.2d at 1357, 50 U.S.P.Q.2d at 1451 (citing *In re Alappat*, 33 F.3d at 1543, 31 U.S.P.Q.2d at 1556-57). Moreover, in making the determination whether the claimed subject matter as a whole is a disembodied mathematical concept or if the concept has been reduced to some practical application rendering it useful, the claims must be construed in the light of the Specification. *See, AT&T Corp.*, 172 F.3d at 1357, 50 U.S.P.Q.2d at 1451 (stating that more than an abstract idea was claimed in *In re Alappat* because the "claimed invention as whole was directed toward forming a specific machine that produced the useful, concrete and tangible result of a *smooth wave form display*") (emphasis supplied). The single claim at issue in *In re Alappat* was directed to a rasterizer and recited elements in means plus function form. *In re Alappat*, 33 F.3d at 1540, 31 U.S.P.Q.2d at 1555. Additionally, none of the limitations recited in the claim at issue expressly claimed a "smooth wave form display". Indeed, the concrete, useful and tangible result relied upon in *In re Alappat*, namely, a smooth uniform display, appears in the background of the invention. *Kuriappan P. Alappat, et al.*, U.S. Patent No. 5,440,676 (col. 1, lines 9-10).

Likewise, in *AT&T Corp.*, the useful, nonabstract result relied upon in holding that the claimed invention was directed to statutory subject matter was that the PIC indicator therein held information about the call recipients PIC, which facilitated differential billing of long-distance calls made by a subscriber. *AT&T Corp.*, 172 F.3d

1358, 50 U.S.P.Q.2d at 1452. However, the claim at issue in *AT&T Corp.* was directed to a method including the steps of generating a message record for an interexchange call, and including in the message record a PIC indicator having a value which is a function of whether or not the interexchange carrier associated with the terminating subscriber is a predetermined one of the interexchange carriers. *AT&T Corp.*, 172 F.3d at 1354, 50 U.S.P.Q.2d at 1449. Again, there was no express or explicit claim limitation directed to the useful, concrete, and tangible result relied upon in determining that the aforesaid claim was directed to statutory subject matter. *See, Id.* The relied upon PIC indicator that facilitates differential billing of long-distance calls appears, *inter alia*, in the summary of the invention. *Gerard P. Doherty, et al.*, U.S. Patent No. 5,333,184, col. 1, line 66 through col. 2, line 3.

Likewise, in *State Street Bank & Trust v. Signature Financial Group*, a useful and concrete and tangible result not expressed in an explicit limitation in the claim at issue was relied upon in holding that the claim was directed to statutory subject matter. *See, State Street Bank*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601 (holding that the transformation of data by the claimed data processing system produced a useful, concrete and tangible result, namely a final share price momentarily fixed for recording and reporting purposes). The claimed invention recited no limitation directed to either a final share price or means for momentarily fixing the final share price for recording and reporting purposes. *See, State Street Bank*, 149 F.3d at 1371, 47 U.S.P.Q.2d at 1599. Indeed, the relied upon useful, concrete and tangible result in *State Street Bank*, namely a final share price momentarily fixed, is not explicitly recited in the *State Street Bank* patent, but is effectively a distillation of the Summary of the Invention. *See, R. Todd Boes*, U.S. Patent No. 5,193,056, col. 4, lines 36-61. Thus, it is beyond peradventure that when judging the claimed subject matter as a whole to determine patentability under 35 U.S.C. § 101, the claims must be construed in the light of the specification.

In short, the question whether a claim encompasses statutory subject matter focuses on the essential characteristics of the subject matter, in particular its utility. *State Street Bank*, 149 F.3d at 1375, 47 U.S.P.Q.2d at 1602.

The Examiner contends that the cited claims do not produce a useful, tangible result. However, claims 22-24 clearly do produce a useful, tangible result. For example, referring to claim 22, claim 22 is directed to a method for creating a technical framework for use in delivering a specific set of information technology services for a customer, which includes the steps of: determining a solution scope for the technical framework to be created...; mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model...; creating a list of design objects as a function of the solution scope for the technical framework...; designating relationships between the design objects as a function of the solution scope.... These are steps that are directed to a useful, tangible, result, namely creating a technical framework for use in delivering a specific set of information technology services for a customer.

Claims 23 and 24 are similarly directed to a useful, tangible, result, namely creating a technical framework for use in delivering a specific set of information technology services for a customer.

As stated above, the inquiry under 35 U.S.C. §101 is whether there is a practical application, or result. *State Street Bank*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601. As discussed above, claims 22-24 are directed to a method, a technical framework and computer program product for delivering a specific set of information technology services for a customer. Hence, the subject matter of claims 22-24 has a practical application within the four statutory categories and is not an idea, a law of nature or a natural phenomenon.

Thus, Applicants respectfully contend that claims 22-24 constitute statutory subject matter. Applicants respectfully assert that the rejections of claims 22-24 under 35 U.S.C. §101 are in error.

## II. PROVISIONAL REJECTION UNDER OBVIOUSNESS-TYPE DOUBLE PATENTING:

The Examiner has provisionally rejected claims 22-25 under the judicially created doctrine of obviousness-type double patenting in view of claims 1-23 of copending Application No. 09/875,863. Further, the Examiner has provisionally rejected

claims 22-25 under the judicially created doctrine of obviousness-type double patenting in view of claims 25-30 of copending Application No. 09/875,865.

Since none of these Applications at issue have been allowed, Applicants defer responding to this rejection.

Applicants note that if the "provisional" double patenting rejection is the only rejection remaining in an application (either the present application or in Application No. 09/875,863 or in Application No. 09/875,865), then the Examiner should withdraw the rejection and permit that application to issue as a patent. M.P.E.P. §804. The "provisional" double patenting rejection may then be converted into a double patenting rejection in the other application at the time the one application issues as a patent. M.P.E.P. §804.

### III. REJECTIONS UNDER 35 U.S.C. §102(e):

The Examiner has rejected claims 22-25 under 35 U.S.C. §102(e) as being anticipated by Hill et al. (U.S. Patent No. 6,670,973) (hereinafter "Hill"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

Applicants respectfully assert that Hill does not disclose "determining a solution scope for the technical framework to be created, the solution scope guided by an information technology services contract with the customer, the solution scope based on common practices for delivering certain types of information technology services" as recited in claim 22 and similarly in claims 23-25. The Examiner cites column 1, line 53 – column 2, line 10; and column 3, lines 10-65 of Hill as disclosing the above-cited claim limitations. Office Action (7/27/2006), page 5. Applicants respectfully traverse.

Hill instead discloses a method performed on a computer for representing the information technology infrastructure of an organization which includes storing data

representing information technology elements of an organization, organizational elements of the organization, and relationships between the information technology elements and the organizational elements. Column 1, lines 53-59. Hill further discloses that to generate hierarchical list 62 and hierarchical graph 54, processing device 22 includes a processor 24 and a memory 26. Column 3, lines 9-11. Hill additionally discloses that memory 26 stores representations of the information technology elements of the organization, the organizational elements of the organization, and the relationships between the information technology elements and the organizational elements. Column 3, lines 11-15.

There is no language in the cited passages that discloses determining a solution scope for the technical framework to be created. Neither is there any language in the cited passages that discloses that the solution scope is guided by an information technology services contract with the customer. Neither is there any language in the cited passages that discloses that the solution scope is based on common practices for delivering certain types of information technology services. Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

Applicants further assert that Hill does not disclose "mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model, the technical model describing people, processes, tools and information used to deliver specific services to customers, the architectural building blocks comprising architectural components that are sufficiently modular and bounded to be described as self-contained entities" as recited in claim 22 and similarly in claims 23-25. The Examiner cites column 4, lines 35-55; column 6, line 64 – column 7, line 10; and column 9, lines 1-55 of Hill as disclosing the above-cited claim limitations. Office Action (7/27/2006), page 6. Applicants respectfully traverse.

Hill instead discloses an example of one of data files 48 stored in database 46 for use in system 10. Column 4, lines 38-39. Hill further discloses that section 61 presents hierarchical list 62, which is illustrated as a tree diagram. Column 6, lines 64-65. Hill

additionally discloses that hierarchical graph 54 corresponds with hierarchical list 62 in interactive user interface 60. Column 9, lines 15-16.

There is no language in the cited passages that discloses mapping the customer's existing equipment to lowest level abstractions of architectural building blocks in a technical model. Neither is there any language in the cited passages that discloses that the technical model describes people, processes, tools and information used to deliver specific services to customers. Neither is there any language in the cited passages that discloses that the architectural building blocks comprise architectural components that are sufficiently modular and bounded to be described as self-contained entities. Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

Applicants further assert that Hill does not disclose "creating a list of design objects as a function of the solution scope for the technical framework, the design objects based on logical groupings of architectural building blocks, including software and hardware components" as recited in claim 22 and similarly in claims 23-25. The Examiner cites column 3, line 24 – column 4, line 35 and column 9, lines 1-55 of Hill as disclosing the above-cited claim limitation. Office Action (7/27/2006), page 6. Applicants respectfully traverse and assert that Hill instead discloses that in operation, data collection module 32, data importation module 34, and /or data entry module 36 allow computer program 42 to obtain data that represents the information technology elements, the organizational elements, and the relationships between them. Column 3, lines 35-39. Hill additionally discloses that hierarchical graph 54 corresponds with hierarchical list 62 in interactive user interface 60. Column 9, lines 15-16. There is no language in the cited passages that discloses creating a list of design objects. Neither is there any language in the cited passages that discloses creating a list of design objects as a function of the solution scope for the technical framework. Neither is there any language in the cited passages that discloses that the design objects are based on logical groupings of architectural building blocks. Neither is there any language in the cited passages that discloses that the design objects are based on logical groupings of architectural building blocks, including software and hardware components. Thus, Hill

does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

Applicants further assert that Hill does not disclose "designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer" as recited in claim 22 and similarly in claims 23-25. The Examiner cites column 4, lines 1-7 of Hill as disclosing the above-cited claim limitation. Office Action (7/27/2006), page 6. Applicants respectfully traverse and assert that Hill instead discloses that interactive user interface 60 allows a user of computer 42 to modify the relationships between the information technology elements and the organizational elements, as well as the elements themselves. Column 4, lines 4-7. There is no language in the cited passage that discloses designating relationships between the design objects and the specific set of information technology services. Neither is there any language in the cited passage that discloses designating relationships between the design objects as a function of the solution scope and the specific set of information technology services for the customer. Thus, Hill does not disclose all of the limitations of claims 22-25, and thus Hill does not anticipate claims 22-25. M.P.E.P. §2131.

As a result of the foregoing, Applicants respectfully assert that not each and every claim limitation was found within Hill, and thus claims 22-25 are not anticipated by Hill. M.P.E.P. §2131.



IV. CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 22-25 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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